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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,562	03/31/2004	Mohamed Zaiou	15670-076001 / 2002-119	5767

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EXAMINER

MITRA, RITA

ART UNIT PAPER NUMBER

1653

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/815,562	Applicant(s) ZAIYOU MOHAMED	
	Examiner Rita Mitra	Art Unit 1653	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 3-10.
Claim(s) objected to: _____.
Claim(s) rejected: 22.
Claim(s) withdrawn from consideration: 23 and 24.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3

New claims 23 and 24 have been added. No claim from the finally rejected claims has been cancelled. Claims 23 and 24 have raised new issues, which would require further consideration and search.

Continuation of 11

In regard to the rejection of claim 22 under **35 U.S.C. 112, first paragraph, enablement** Applicants traverse the rejection. In particular Applicants submit that the Examiner misreads the cited cases and application of “consisting essentially of” in MPEP 2111.03, “Transitional phrases.” Applicants arguments at pages 7-9 of the “Remarks” have been considered fully but not found persuasive because MPEP 2111.03, “Transitional phrases” recites that >“A ‘consisting essentially of’ claim occupies a middle ground between closed claims that are written in a ‘consisting of’ format and fully open claims that are drafted in a ‘comprising’ format.” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998).< See also *Atlas Powder Co. v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. v. Calco, Ltd.* 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). Thus the open language “consisting essentially of” in claim 22 is interpreted as “comprising.”

In the instant case, the amount of experimentation is required to practice the claimed invention is undue as the claims encompass an unspecified amount of polypeptides and variants/fragments of sequences set forth in SEQ ID NO: 2.

Note that claim 22 recites a method for inhibiting the growth of a bacterium or yeast comprising contacting the bacterium or yeast with a peptide consisting essentially of an amino acid sequence as set forth in SEQ ID NO: 2 from about amino acid 31-to 131. The recitation of the open language “consisting essentially of” (same as “comprising”) means the components not listed could be a part of the claimed peptide, for example there could be more than one sequence,

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and the sequence could have amino acid residues added to the N-terminal or C-terminal end of the sequence.

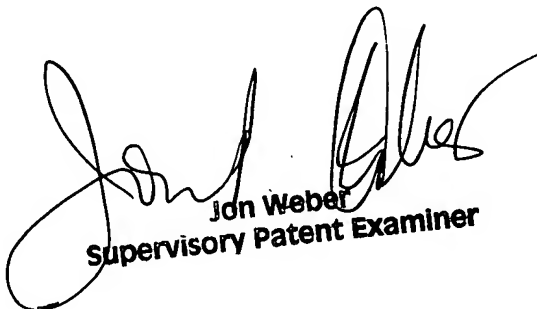
Further, the specification at page 16-18 indicates that the method according to the invention can be used to produce analogs, derivatives, conservative variations and cationic cathelin-like peptide variants. However, the claimed peptide once modified may not have the same properties of the parent peptide or retain the same function. Additionally there is no data provided demonstrative of a particular portion of the structure that must be conserved. Since the number of changes from the specific sequence are large, one of skill in the art would have to make and test each one to determine if it was a "cationic cathelin-like peptide and had the antimicrobial activity.

Thus claim 22 stands rejected under 35 U.S.C. 112, first paragraph, scope of enablement.



Rita Mitra, Ph.D.

July 26, 2006



Jon Weber
Supervisory Patent Examiner